

Appln. No. 10/065,486
Docket No. 124695/GEM-0058

REMARKS / ARGUMENTS

Applicant thanks the Examiner for reconsideration and withdrawal of the previous rejection under 35 U.S.C. §101.

Status of Claims

Claims 1-17 and 21-28 are pending in the application and stand rejected.

Applicant has amended Claims 1, 9, 15, 21 and 24, leaving Claims 1-17 and 21-28 for consideration upon entry of the present Amendment.

Applicant respectfully submits that the rejections under 35 U.S.C. §102(e) and 35 U.S.C. §103(a) have been traversed, that no new matter has been entered, and that the application is in condition for allowance.

These amendments and accompanying remarks were not presented earlier because Applicant did not fully appreciate the nature of the Examiner's position until the Applicant was advised in more detail of the position by the final rejection. The claim amendments presented herein, which Applicant respectfully requests entry thereof, should require only a cursory review by the Examiner as they include only clarifying language.

Rejections Under 35 U.S.C. §102(e)

Claims 1, 3, 4, 6, 7, 9, 11-15, 21, 24, 26 and 27 stand rejected under 35 U.S.C. §102(e) as being anticipated by Barni (U.S. Patent No. 6,473,634, hereinafter Barni).

Applicant traverses this rejection for the following reasons.

Applicant respectfully submits that “[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, *in a single prior art reference.*” *Verdegaal Bros. V. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987) (emphasis added). Moreover, “[t]he identical invention must be shown in as complete detail as is contained in the *** claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). Furthermore, the single source must disclose all of the claimed elements

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"arranged as in the claim." Structural Rubber Prods. Co. v. Park Rubber Co., 749 F.2d 707, 716, 223 U.S.P.Q. 1264, 1271 (Fed. Cir. 1984). Missing elements may not be supplied by the knowledge of one skilled in the art or the disclosure of another reference. Titanium Metals Corp. v. Banner, 778 F.2d 775, 780, 227 U.S.P.Q. 773, 777 (Fed. Cir. 1985).

Applicant has amended independent Claims 1, 9, 15 and 21 to now recite, *inter alia*,

"...the imaging system comprising a detector array having a detector coverage in a defined direction ...

... processing said target area by subdividing said target area in the defined direction so as to create a plurality of sub-target areas of interest that are multiples of the detector coverage in the defined direction...",

and has amended independent Claim 24 to include similar limitations.

No new matter has been added as antecedent support may be found in the application as originally filed, such as at Paragraphs [0028] and [0045], for example.

Dependent claims inherit all of the limitations of the respective parent claim.

In alleging anticipation, the Examiner remarks that "Barni (at col. 3, lines 51-54) discloses a method of subdivision of target areas into a plurality of smaller areas of interest, namely pixels or voxels." Instant Office Action, page 6.

Here, the Examiner broadly reads the claimed "sub-target areas" as being pixels or voxels.

In respectful disagreement with the Examiner, Applicant submits that the claimed sub-target areas must be read in light of the specification, which clearly describes the sub-target areas to be multiples of the detector coverage in the Z-axis (patient table direction or defined direction), which is substantially different from sub-target areas being individual pixels. Paragraph [0045].

When read in light of the specification, one skilled in the art would appreciate the scope of the invention to be directed to subdividing the target area of interest into sub-target areas that are multiples of the detector coverage in the defined direction (Z-axis).

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Notwithstanding a reading of the claimed invention in light of the specification, Applicant has nonetheless amended the independent claims to include clarifying language that more particularly describes the claimed invention.

In view of the amendments set forth above, Applicant submits that Barni does not disclose each and every element of the claimed invention arranged as claimed, since the Examiner has already indicated that Barni discloses sub-target areas that are pixels, and not sub-target areas that are multiples of the detector coverage in the defined direction.

Accordingly, Applicant submits that Barni does not disclose all of the claimed elements arranged as in the claim, and absent anticipatory disclosure in Barni of each and every element of the claimed invention arranged as in the claim, Barni cannot be anticipatory.

In view of the amendment and foregoing remarks, Applicant submits that Barni does not disclose each and every element of the claimed invention arranged as claimed and therefore cannot be anticipatory. Accordingly, Applicant respectfully submits that the Examiner's rejection under 35 U.S.C. §102(e) has been traversed, and requests that the Examiner reconsider and withdraw of this rejection.

Rejections Under 35 U.S.C. §103(a)

Claims 2, 5, 10, 16 and 22 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Barni in view of General Electric Company (European Patent No. 1090586, hereinafter EP 1090586).

Claims 8, 17 and 23 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Barni in view of Shao et al. (U.S. Publication No. 2003/0233039, hereinafter Shao).

Claims 25 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barni in view of Hu et al. (U.S. Patent No. 6,073,041).

Applicant traverses these rejections for the following reasons.

Applicant respectfully submits that the obviousness rejection based on the References is improper as the References fail to teach or suggest each and every element of the instant invention in such a manner as to perform as the claimed invention performs.

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For an obviousness rejection to be proper, the Examiner must meet the burden of establishing a prima facie case of obviousness. *In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988). The Examiner must meet the burden of establishing that all elements of the invention are taught or suggested in the prior art. MPEP §2143.03.

In view of the secondary references being applied to reject dependent claims, and in view of Applicants amendments set forth above to clarify the scope of the claimed invention, Applicant submits that the secondary references fail to teach or suggest the limitations of the now amended claims, and for at least this reason Applicant submits that the combination of references applied to reject the noted claims for obviousness fail to establish a prima facie case of obviousness and therefore cannot be properly applied to reject the noted claims.

In addition to the foregoing, Applicant finds no motivation or teaching in any of the References to modify a primary Reference in view of its respective secondary Reference to arrive at the claimed arrangement of elements without disturbing the two temporal resolutions and intended purpose of the art being modified, namely Barni.

In view of the foregoing, Applicant submits that the References fail to teach or suggest each and every element of the claimed invention and are therefore wholly inadequate in their teaching of the claimed invention as a whole, fail to motivate one skilled in the art to do what the patent Applicant has done, fail to offer any reasonable expectation of success in combining the References to perform as the claimed invention performs, fail to teach a modification to prior art that does not render the prior art being modified unsatisfactory for its intended purpose, and discloses a substantially different invention from the claimed invention, and therefore cannot properly be used to establish a prima facie case of obviousness. Accordingly, Applicant respectfully requests reconsideration and withdrawal of all rejections under 35 U.S.C. §103(a), which Applicant considers to be traversed.

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Applicant has amended the claims for presentation in a better form that more clearly reflects Applicant's invention. The claim amendments should only require a cursory review by the Examiner as they include only clarifying language.

In light of the foregoing remarks and amendments, Applicant respectfully submits that the proposed amendments and arguments comply with 37 C.F.R. §1.116 and should therefore be entered, and with their entry that the Examiner's rejections under 35 U.S.C. §102(e) and 35 U.S.C. §103(a) have been traversed, and that the application is now in condition for allowance. Such action is therefore respectfully requested.

The Commissioner is hereby authorized to charge any additional fees that may be required for this amendment, or credit any overpayment, to Deposit Account No. 07-0845.

In the event that an extension of time is required, or may be required in addition to that requested in a petition for extension of time, the Commissioner is requested to grant a petition for that extension of time that is required to make this response timely and is hereby authorized to charge any fee for such an extension of time or credit any overpayment for an extension of time to the above-identified Deposit Account.

Respectfully submitted,
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